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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/132,746	08/12/1998	HAJIME YAMAMOTO	35.C12902	9960

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/17/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/132746

Applicant(s)

Yamamoto et al.

Examiner

John Guarriello

Group Art Unit

1791

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 4/24/2002, 7/30/2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-6, 11-25, 30-39, 42, 47-62, 65, 68-76, 79-95 is/are pending in the application.

Of the above claim(s) 1-6, 11-17, 31-39, 54-62, 79, 82, 83, 87, 90-92 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 is/are rejected.

☒ Claim(s) 18, 42, 65 is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) #21

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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### **DETAILED ACTION**

15. The Examiner acknowledges papers # 21-22, the IDS of 4/24/2002, the extension of time, and the amendment of 7/30/2002.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Election/Restriction***

17. The restriction is made final as noted in paper # 17 of 6/6/2001. Upon the submission of new claims 87-95, non-elected claims are 87, 90-92. New claims 88, 89, 93-95 are directed to the elected invention, Group II, fibrous material.

#### ***Specification***

18. The use of the trademarks "Acetylenol E-H" and "Surfonyl 465" has been noted in this application, pages 15, 19, 20, 63, 64, 65, 77, and 81. They should be **capitalized** wherever they appears and be accompanied by the generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Applicant's arguments regarding the basis for requiring capitalization of Trademarks are noted. See MPEP 608.01(v), page 600-83, titled Trademarks and Names used in Trade, which sets the criteria for the proper treatment of Trademarks and Names in patent applications.

### ***Claim Objections***

19. Claims 18, 42, and 65 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous article claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form which is to the elected invention a fibrous material, Group II, or rewrite the claim(s) in independent form. Applicant's arguments have been considered but the

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arguments are predicated upon the petition which is not present in the application, thus the arguments are not persuasive.

***Claim Rejections - 35 USC § 102***

20. Claims 18-21, 30, 42, 65, 71, 72, 76, 88, 89 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 771 662.

EP'662 describes an ink absorbing body which stores ink, (see abstract). EP'662 describes the surface of the ink absorbing body is treated with a surfactant,( page 8, lines 2-51), in the range of 0.002 to 0.2 wt.% relative to the weight of the ink, or in a range of 0.01 to 0.5 wt.% relative to the weight of the fiber, (see abstract; page 7, lines 10-53). EP'662 describes a polypropylene ink tank container, (page 10, lines 10-15). EP'662 describes the essential limitations of the claimed invention. Claims lack novelty. Applicant's arguments regarding glycol treatment have been considered but they are not deemed to be persuasive because '662 describes glycol treatment, see page 8, lines 4-7.

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***Claim Rejections - 35 USC § 103***

21. Claims 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ujita et al. 5,784,088 in view of Koitabashi et al. 5,509,140.

Rejection is maintained substantially as in paper # 13 of 9/11/200 and paper # 17 of 6/6/2001. Applicant's arguments regarding Ujita with a treatment for hydrophilic properties of the fibrous materials (like spun yarn) have been considered but the problem of ink flow, (column 3, lines 36-38) are described. Applicant's arguments regarding Koitabashi with the surfactant have been considered but Koitabashi describes anionic surfactants (column 38, lines 49-66; column 39, lines 1-5) as well as nonionic surfactants, (column 3<sup>9</sup><sub>3</sub>, lines 41-66). Koitabashi describes acetylene glycol-ethylene oxide adducts and how it affects image quality and penetration of the ink. The claimed invention would still be obvious to one of ordinary skill without evidence of aspects of criticality of the amounts of the components required for the claimed invention.

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Applicant's arguments regarding the glycol were responded to in the action of paper # 13 of 9/11/2000, paragraph # 22, page 6.

22. Claims 22-25, 47-53, 68-70, 73-75, 84-86, 93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 771 662 in view of Koitabashi et al. 5,509,140.

EP'662 as above in paragraph # 21. EP'662 differs from the claimed invention because the treating agent glycol is different.

Koitabashi as in paper # 13 of 9/11/2000, paragraph 22, page 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the ethylene oxide adduct of acetylene glycol of Koitabashi for the glycol surfactant of EP'662 motivated with the expectation that this would be an improvement in the ink transfer properties of the ink absorbing member of EP'662.

Applicant's arguments regarding the glycol have been considered but they are not deemed to be persuasive because these were answered in paper # 13 of 9/11/2000, paragraph 22, page 6.

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### ***Double Patenting***

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claims 18-25, 30, 42, 47-53, 65, 68-76, 80, 81, 84-86, 88, 89, 93-95 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,234,618 in view of EP 771 662. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would



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have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hydrophobicity of the fibers of '618 with the surfactant of EP'662 as described motivated with the expectation that treatment of the fibers by surfactants corresponding to EP 771 662, page 8, lines 3-50, for hydrophobic properties is routine in the art and the optimization of the appropriate amounts of the surfactants and types of surfactants (non-ionic, ionic, cationic, or anionic) to accomplish this treatment of the fibers for hydrophobicity are routine to the person of ordinary skill in the fiber treatment art, see *In re Aller*, 105 USPQ 233.

Applicant's previous response of 12/26/2001 never responded to the rejection of record as a double patenting rejection, thus it was repeated. Regarding applicant's present response of 7/30/2002, EP'662 does describe a glycol treatment, page 8, lines 4-7.


25. Rejections not maintained are withdrawn under 35 USC 112 second paragraph for claims 19 and 30.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
John J. Guarriello:gj

Patent Examiner

October 8, 2002

October 10, 2002

  
ELIZABETH M. COLE  
PRIMARY EXAMINER